

REMARKS

The Official Action of August 7, 2008 and references cited therein have been carefully considered. The amendments and remarks herein are considered
5 to be responsive thereto. The claims remaining in the case are 1 through 25. No new matter has been added.

Claims 26-28 are rejected under 35 USC 112, first paragraph, because the specification while possibly being enabling for treating specific diseases, does not reasonably provide enablement for preventing diseases. The claims are also rejected
10 under 35 USC 112, first paragraph, for failing to comply with the written description requirement. Specifically, the Examiner states that the specification does not adequately describe the nexus between the modulation of the PDE-4 receptor and a useful treatment of a disease/condition. The claims are further rejected under 35 USC 112, first paragraph, for lacking enablement. Claims 26-28 have been canceled
15 without prejudice to refile.

Claims 1-28 are rejected under 35 USC 103(a) as being unpatentable over Dube (US7153968 and US6919353) and Boschelli (US6521618). The Examiner alleges that the difference between the instant claims and the prior art is that Dube and
20 Boschelli teach the markush but do not specifically teach a compound that falls within the instant claims. Applicants respectfully traverse. A more careful review of US6919353 will reveal that its markush does not have an aryl or heterocyclyl directly attached to the phenyl as required by the instant invention. Likewise, the markush in US6521618, in particular the quinoline, must always have two substituents on the "N"
25 containing ring of the molecule. Thus, neither Dube (US6919353) or Boschelli teach the instantly claimed markush. As the 103(a) rejection should be more appropriately referred to as a 103(a)/102(e) rejection, US7153968 is disqualified as a 103(a) reference disqualified pursuant to 35 U.S.C. 103(c) as prior art in a rejection under 35 USC 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2). The instantly claimed
30 invention and US7153968 were commonly owned by Merck & Co., Inc. at the time of the invention.

In light of the amendments and remarks herein Applicants believe the claims are in condition for allowance. The Examiner is respectfully requested to contact the undersigned at the number below if this would expedite the allowance.

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Respectfully submitted,

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